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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,569	12/21/1999	WOLFGANG WEIDNER	826	4514
7590 01/05/2009 STRIKER STRIKER & STENBY 103 EAST NECK ROAD HUNTINGTON, NY 11743				
			EXAMINER TORRES, MARCOS L	
			ART UNIT 2617	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/367,569
Filing Date: December 21, 1999
Appellant(s): WEIDNER ET AL.

Michael J. Striker
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9-9-08 appealing from the Office action mailed 5-14-08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,396,547

Baals

3-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 23 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsoi US005633912A in view of Baals US005396547A.

As to claim 23, Tsoi discloses a radio apparatus embodied in a radio telephone (see fig. 5, item 62), comprising a display device (see fig. 7, items 74,76); a first control element and a second control element each for selecting and/or activating functions of the radio apparatus which are displayed on said display device (see fig.5, items 82-92; col. 6 ,lines 40-43); said first and second control elements being disposed neighboring said display device so that a local association exists between said first and second control elements and displaying of functions of the radio apparatus on said display device (see col. 2, lines 50-53), wherein a first operating state is provided in which an information about said first operating state on said display device is associated with said first control element, and in which a function for activation of a second operating state on said display device is associated with said second control element, wherein said second operating state is associated with said first operating state, and wherein in said second operating state an information about said second operating state on said display device is associated with said second control element, and in which a function for activation of said first operating state on said display device is associated with said first control element (see col. 6, lines 62-65; col. 7, lines 1-6 and fig. 7-13). Tsoi does not specifically disclose wherein said first or second control element to merely show the information about said first or second operating state are assigned. In an analogous art,

Baals discloses wherein a first and second control element having no function and merely the information about said first and second operating state are assigned (see fig. 6). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to display additional information of the operating state of the device for the simple purpose of informing the user thereby enhancing user satisfaction and preventing users from entering an improper key.

As to claim 22, Tsoi discloses a radio apparatus, wherein said radio apparatus comprises third and fourth control elements for selecting and/or activating functions of said radio apparatus and wherein in said first and second operating states said third and fourth control elements are associated with respective functions of the radio apparatus which remain unchanged upon a change between said first and second operating states (note that in fig. 8 and 9 items 82 does not change; in fig. 7 and 10, item 92 does not change; in fig. 12 and 13 items 82, 84, 86 and 92 do not change).

(10) Response to Argument

Appellant asserts that Tsoi fails to disclose "an arrangement in which pressing a button causes a transition to a different operating state in which that button has no function - in each case the button is associated with a function for transitioning to a further operating state.". Tsoi discloses this limitation for example looking at fig. 7, the bottom display uses only the first two soft keys and the last two soft keys, however when a call is dialed it changes to fig. 8 and only the first key have a function during dialing (see col. 6, operation). Thereby, pressing a call button causes a transition to a different operating state in which three buttons has no function. Please note that this

exemplary illustration since there are a lot of operating states, there is also various interpretations.

Also appellant asserts that the references are not combinable; the examiner respectfully disagrees. Tsoi teaches using "soft keys" control element which are associated with the display are used to change the operating state of a phone (see col. 6, lines 62-65; col. 7, lines 1-6 and fig. 7-13). Baals discloses using using "soft keys" control element which are associated with the display are used to change the operating state of a phone and the display to show messages in a phone, including displaying information about the operating states while the soft keys have no function [only displaying status information (see fig. 6)]. Therefore, a combination of both references would bring a phone in which If additional information needs to be displayed, the bottom display in Tsoi could also be used to display that additional information [for example if the upper display is full], and show operational information. Thereby, both references are analogous and properly combinable.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Marcos L Torres/

Examiner, Art Unit 2617

Art Unit: 2617

Conferees:

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